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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/765,400	01/28/2004	Jun Miyajima	00862.023442	2547
5514 7590 10/04/2007 FITZPATRICK CELLA HARPER & SCINTO 30 ROCKEFELLER PLAZA NEW YORK, NY 10112			EXAMINER SEVERSON, JEREMY R	
			ART UNIT 3653	PAPER NUMBER
			MAIL DATE 10/04/2007	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/765,400	<b>Applicant(s)</b> MIYAJIMA, JUN	
	<b>Examiner</b> Jeremy R. Severson	<b>Art Unit</b> 3653	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 23 July 2007.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1,3-5,7 and 8 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,3-5,7 and 8 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 28 January 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 19 June 2007 has been entered.

### ***Claim Objections***

Claim 1 is objected to because of the following informalities: in line 10 of claim 1, the Examiner believes "all of the elements of a predetermined condition are satisfied" was intended by Applicant. Appropriate correction is required.

### ***Claim Rejections - 35 USC § 103***

Claims 1, 3-5, 7 and 8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dei (US 4,763,889) in view of Tomidokoro (US 5,722,029).

Re claims 1 and 5, Dei discloses an image forming apparatus having a plurality of paper feed units capable of setting index sheets, comprising: a storage section (4-6) which stores paper size information and type information; and a control section (16) which performs processing of automatically changing the paper feed unit to be used

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from a first paper feed unit to a second paper feed unit and does not perform processing of automatically changing the paper feed unit from the first paper feed unit to a third paper feed unit in a case where paper sheets set in the first paper feed unit are run out and all of the elements of a predetermined condition are satisfied, wherein the predetermined condition is that the size information and the type information of the first paper feed unit coincide with those of the second paper feed unit, and the size information and type information of the first paper feed unit do not coincide with those of the third paper feed unit, and the size information and type information of the first paper feed unit coincide with those of the second paper feed unit. See, e.g., Dei, col. 2, lines 17-35.

Dei lacks the explicit disclosure of the storage section storing index number information indicating the number of index sheets per set of paper sheets set in each paper unit. Tomidokoro teaches a storage section storing index number information indicating the number of index sheets per set of paper sheets set in each paper unit, for accurate tab copying. See Tomidokoro, col. 8, lines 46 et seq. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to add a storage section storing index number information indicating the number of index sheets per set of paper sheets set in each paper unit, to the apparatus of Dei, as taught by Tomidokoro, for accurate tab copying.

Dei teaches the desirability of using operator-set parameters regarding the paper types to govern the automatic change of paper feed units. See Dei, col. 5, lines 17-45. Therefore, it would have been obvious to one of ordinary skill in the art at the time the

invention was made to use the number of index sheets set in each paper unit to govern the automatic change of paper feed units in the manner described above.

Re claims 3 and 7, the apparatus of Dei as modified by Tomidokoro comprises the apparatus according to claim 1.

Dei does not explicitly disclose said storage section storing index shape information indicating a shape of the index portion of the paper sheet set in the paper feed units, wherein the index shape information of the first paper feed unit coincides with that of the second paper feed unit, and wherein at least one of the size information, index number information and the index shape information of the first paper feed unit do not coincide with those of the third paper feed unit. Tomidokoro teaches a storage section storing index shape information, for accurate tab copying. See Tomidokoro, col. 8, lines 17 et seq. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to add a storage section storing index shape information to the apparatus of Dei, as taught by Tomidokoro, for accurate tab copying.

Dei teaches the desirability of using operator-set parameters regarding the paper types to govern the automatic change of paper feed units. See Dei, col. 5, lines 17-45. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to use the index shape information set in each paper unit to govern the automatic change of paper feed units in the manner described above.

Re claims 4 and 8, the apparatus of Dei as modified by Tomidokoro comprises the apparatus according to claim 1, wherein the image forming apparatus further comprises a unit change setting section which determines whether to automatically enable paper feed unit change processing for each of the plurality of paper feed units and sets a unit change setting in accordance with a predetermined condition, wherein the predetermined condition is that the unit change setting section sets the unit change setting to automatically enable change processing for the second paper feed unit. See Dei, cols. 3 and 4.

### ***Response to Arguments***

Applicant's arguments filed 19 June 2007 have been fully considered but they are not persuasive.

Applicant argues that the two references, Dei and Tomidokoro, whether taken alone or individually, do not teach or suggest the invention. Applicant argues that Dei only discloses an image forming apparatus performing a change of paper feed unit based on two kinds of information, not three. Applicant argues that Tomidokoro fails to disclose any technique or method relating to a storage section storing index number information used for the purposes of automatically changing the paper feed unit.

Remarks, p 8-9. The Examiner respectfully disagrees that Dei and Tomidokoro do not teach or suggest the invention. Dei discloses an image forming apparatus performing a change of paper feed unit based on several potential types of information, including size, material, color and orientation. Dei does not specifically address index sheets.

However, based on the teaching of Dei that an automatic change of paper feed can be based on a parameter related to the contents of the paper feed source, combined with Tomidokoro's teaching of the number of index sheets per set as a stored parameter that is used for accurate tab copying, it would have been obvious to a person of ordinary skill in the art to perform a change in paper feed based on the number of index sheets per set in the paper feed source.

### ***Conclusion***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jeremy R. Severson whose telephone number is (571) 272-2209. The examiner can normally be reached on Monday through Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Patrick Mackey, can be reached on 571-272-6916. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Jeremy R Severson  
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jrs

  
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